

applicants exercised reasonable diligence from September 26, 1997 to October 2, 1997 and from October 2, 1997 to December 13, 1997. In response, applicants respectfully submit the enclosed Declaration under 37 CFR 1.132, Declaration under 37 CFR 1.131, and portions of the AIPLA Report of the Economic Survey (2003) to provide the evidence of diligence as requested by the Examiner.

Also, as identified in the enclosed Letter to the Examiner, enclosed pursuant to MPEP 724 are copies of the Receipt List and drafts of the applications corroborating Mr. Lee's statements in items 15 and 16 of the enclosed Declaration. It is respectfully submitted that the material contains proprietary information. A Petition under 37 CFR 1.59 has been filed with this Response to expunge this material.

Applicants request entry of this Rule 116 Response and the evidence submitted herewith as being newly required in a final Office Action. Specifically, the Examiner had previously asserted on pages 2-3 of the Office Action mailed December 17, 2003 that the evidence showed diligence earlier than the foreign filing date of December 13, 1997. However, the Examiner now requires such evidence for the first time in a Final Office Action. As such, the applicants respectfully submit that the enclosed evidence is submitted in timely fashion and that entry is appropriate. MPEP 715.09.

As a general matter, in relying on a date of invention prior to a constructive reduction, applicants are entitled to rely on the diligence of an attorney preparing the application since the diligence of the attorney in preparing and filing the application "inures to the benefit of the inventor." MPEP 2138.06. In determining diligence by the attorney, the standard is whether the attorney acted with *reasonable* diligence in preparing the application. As such, there is no requirement that the attorney have prepared the application to the exclusion of all other work, or that all time be accounted for in minute detail so long as the attorney acted on the application and in due course in light of the attorney's remaining workload.

On pages 2-3 of the Office Action, the Examiner cites to various cases in which diligence

was not shown in reducing an application to practice. However, while these cases set forth specific and short periods of time, it is noted that the finding of a lack of diligence related to additional factors showing extensive inactivity, a small part of which included the critical time period. By way of example, while the critical period in In re Mulder, 219 USPQ 189 (Fed. Cir. 1983) is asserted to be a two day lapse, it is noted that the actual lack of activity was almost a year during which time no evidence of diligence was offered such that the evidence showed a near continuous inactivity. Since the critical two days occurred in this period of inactivity, the nearly one year of inactivity was important in supporting a finding that there was a lack of diligence during these two days. Similarly, in Fitzgenald v. Arbib, 122 USPQ 530 (CCPA 1959), the record lacked evidence of diligence over a period of close to six months (including the critical one month period), during which time drawings were not being worked on to complete conception. Thus, the extent of the inactivity beyond the critical period supported a finding of a lack of diligence within the much shorter critical period. As such, while the summary of the cases cited by the Examiner set forth small periods of inactivity that can support a finding of a lack of diligence, it is respectfully submitted that the bulk of the evidence in these cases showed extensive amounts of time (including the critical time frames) during which no activity was taken.

In contrast to these cases, where there is evidence of activity within a reasonable amount of time and the activity evidences continuing and reasonable efforts at drafting and filing the application, this evidence is sufficient to prove earlier dates of invention. As noted in MPEP 2138.06, six days has been held reasonable for an attorney to have an application executed and filed. Haskell v. Coleburne, 213 USPQ 192, 195 (CCPA 1982). The inquiry is whether the evidence shows that attorney worked "reasonably hard on the application during the continuous critical period. If the attorney has a reasonable backlog of unrelated cases which he takes up in chronological order and carries out expeditiously, that is sufficient." MPEP 2138.06 citing Bey v. Kollonitsch, 231 USPQ 967 (Fed. Cir. 1986). Thus, mere pauses occurring during the preparation of the application are not, in and of themselves, indicators that the applicants did not

exercise reasonable diligence in preparing and filing an application.

By way of example, in English v. Ausnit, the Board of Patent Appeals and Interferences found reasonable diligence in constructively reducing an application to practice over a six month period from June 20, 1986 to December 22, 1986. In making this decision, the Board noted that the evidence showed that the attorney received, docketed, assigned, and began working on drawings for an invention disclosure received on June 25, 1986; took up the case in chronological order; completed the drawings on September 3, 1986; completed a draft on November 11, 1986; mailed the completed application for execution by the inventors on November 20, 1986; again mailed a corrected application on December 3, 1986; received the executed declaration and final application on December 15, 1986; and filed the completed application on December 22, 1986. 38 USPQ2s 1625, 1639 (1993). As can be seen in the above timeline, small gaps in this timeline did not preclude a finding of reasonable diligence since there was evidence of continuing and systematic contact and work by the attorney as set forth above.

As evidenced by the enclosed Declarations under 37 CFR 1.132 and 131, Mr. Chang-gil Lee received the invention disclosure form on October 2, 1997, along with six other invention disclosure forms. Included with the invention disclosure forms were instructions that the applications were to be filed within three (3) months. Mr. Lee docketed the invention disclosure on October 3, 1997. As Mr. Lee was working on seven other disclosures during this time, the application was taken up in chronological order in order of receipt. On October 18, 1997, Mr. Lee began an outline of the application. After contacting the inventors on October 22, 1997, Mr. Lee conducted an interview with the inventors on October 25, 1997 to discuss the application. On October 27, 1997, a draft of the application was completed. The completed application was submitted to the inventors for review on November 3, 1997. After receiving comments from the inventors on November 25, 1997, a corrected application was completed and sent to the inventors for execution on November 28, 1997. On December 10, 1997, the executed version of

the application was received for filing. The application was then filed on December 13, 1997.

It is noted that this time frame is within the three-month time frame requested by the applicants. Additionally, it is noted that this amount of time includes many of the same events as outlined in English v. Ausnit, but were completed in almost one-third the amount of time taken by the applicants in English v. Ausnit. As such, it is submitted that the above evidence similarly evidences reasonable diligence in preparing and filing the application and that the reasonable diligence inures to the benefit of the applicants.

Further, Mr. Lee worked on the six other applications during this time and which were worked on in chronological order according to the docket number. While Mr. Lee attests to the fact that he typically only requires nineteen hours to complete an application, on average, it is noted that this time is more rapid than the average time period which an attorney can take to prepare an application. Using facts on page 20 and Table 17d of the AIPLA Economic Survey of 2003, the average time which an attorney can be expected to take in electrical/computer inventions, such as the instant invention, is 34.4 hours (i.e., \$9,995/\$290) for a complex invention, and 18.9 hours (i.e., \$5,504/\$290). Therefore, there is evidence that the amount of time Mr. Lee worked on both the instant application as well as the other applications is the same as or more rapid than that normally expected by someone working diligently to prepare and file an application, and that a reasonable amount of time per application is more than that set forth in the Declaration.

In view of the above, which is corroborated by the inventors in the enclosed Declaration under 37 CFR 1.131, it is respectfully submitted that there is sufficient evidence of record to evidence that the applicants were reasonably diligent in completing and filing their invention as a Korean patent application, and that reasonable diligence has been established between December 13, 1997 and October 2, 1997 which inures to the benefit of the inventors. Since the Examiner confirms on pages 2-3 of the Office Action of December 17, 2003 that a date of conception has been shown prior to the U.S. filing date of Cato, and since the evidence of

records establishes reasonable diligence between at least October 8, 1997 and the date of foreign filing for the above referenced application of December 13, 1997, it is respectfully submitted that the applicants have established a date of invention sufficient to remove Cato as a reference under 35 U.S.C. §102(e). Therefore, it is respectfully submitted that Cato no longer qualifies as prior art under 35 U.S.C. §102(e) since the invention was not "described in a patent granted on an application for patent by another filed in the United States *before the invention thereof by the applicant for patent.*" MPEP 2136.05, MPEP 715.

REJECTION UNDER 35 U.S.C. §102:

On pages 3-12 of the Office Action, the Examiner rejects claims 16-35 and 37-81 under 35 U.S.C. §102(e) in view of Cato (U.S. Patent No. 6,412,111). The rejection is respectfully traversed and reconsideration is requested.

Since Cato is no longer prior art as discussed above, and since the Examiner cites no other prior art as anticipating claims 16-35 and 37-81, it is respectfully submitted that claims 16-35 and 37-81 are deemed patentable.

REJECTION UNDER 35 U.S.C. §103:

In the Office Action at pages 12-14, the Examiner rejects claims 36 and 82-85 under 35 U.S.C. §103 in view of Cato and either the Examiner's taking Official Notice of various elements or Mankovitz (U.S. Patent No. 6,459,719). The rejection is respectfully traversed and reconsideration is requested.

Even assuming arguendo that the Examiner's taking Official Notice of the various elements is proper and Mankovitz discloses the features as described in the Office Action, neither the Examiner's taking Official Notice nor Mankovitz are relied upon as disclosing and do not disclose the features of the recited invention without Cato. Since Cato is not prior art as discussed above, it is respectfully submitted that claims 36 and 82-85 remain patentable over the Examiner's taking Official Notice and/or Mankovitz.

CONCLUSION:

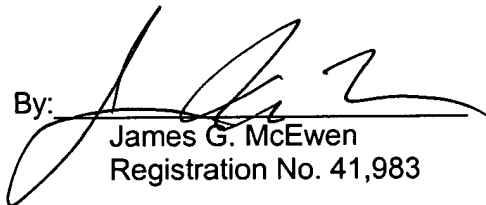
In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. And further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited. At a minimum, this Amendment should be entered at least for purposes of Appeal as it either clarifies and/or narrows the issues for consideration by the Board.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited and possibly concluded by the Examiner contacting the undersigned attorney for a telephone interview to discuss any such remaining issues.

If there are any additional fees associated with the filing of this Response, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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